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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,302	03/12/2004	Mark Winthrop Wheeler	52726.000022	5805
21967 7590 03/20/2009 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			EXAMINER FOREMAN, JONATHAN M	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 03/20/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/798,302

**Applicant(s)**

WHEELER ET AL.

**Examiner**

JONATHAN ML FOREMAN

**Art Unit**

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 54-86 is/are pending in the application.
- 4a) Of the above claim(s) 54-67 and 83-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 68-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 3/12/04 and 3/15/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 54 – 67 and 83 – 86 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/4/08.

### ***Information Disclosure Statement***

2. The information disclosure statements submitted on 3/12/04 and 03/15/05 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 68, 78, 79, 80 and 81 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16, 18, 19, 22 and 24 of U.S. Patent No. 6,730,047. Although the conflicting claims are not identical, claims 68, 78, 79, 80 and 81 are merely broader in scope than claims 16, 18, 19, 22 and 24 of U.S. Patent No. 6,730,047. As such, the subject matter of 16, 18, 19, 22 and 24 of U.S. Patent No. 6,730,047 "anticipates" the subject matter of currently pending claims 68, 78, 79, 80 and 81. Accordingly, claims 68, 78, 79, 80 and 81 are not patentably distinct from 16, 18, 19, 22 and 24 of U.S. Patent No. 6,730,047.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 68 – 73 and 80 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,553,857 to Fish.

In reference to claims 68 – 73 and 80, Fish discloses an apparatus for detecting the motion of a user's head during a repetitive physical activity (Col. 3, lines 55 – 59) having a sensor (40), wearable on the user's head; a processor (60) that stores a predetermined head motion value, receives input from the sensor indicative to the motion of the head gear, and compares the

measured head motion data from the sensor to the stored head motion value; and a feedback indicator that generates a positive or negative feedback signal indicative of the comparison (Col. 5, lines 6 – 15). The processor stores head motion values for a plurality of phases of hitting a golf ball including a forward swing, back swing, midpoint, follow-through and impact (col. 2, lines 35 – 37; Col. 5, lines 45 – Col. 6, line 25). Fish discloses a user interface for inputting information relating to the physical activity (Col. 4, lines 17 – 26).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 74 - 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,553,857 to Fish in view of U.S. Patent No. 4,605,226 to Morrissey.

In reference to claims 74 - 77, Fish discloses determining head motion of a user during a physical activity and providing feedback to a user, wherein predetermined values are compared to input received from the sensors and generating a feedback signal when the input from the sensor deviates from a stored value. Fish does not disclose the activity being hitting a ball with a bat and the predetermined values being a load pitch position, forward head motion and follow-through head motion. However, Fish states that the device can be adapted to many sporting activities (Col. 3, lines 60 – 67). Morrissey teaches that head position throughout a swing when hitting a ball with a bat is critical in achieving solid contact with the ball (Col. 1, lines 14 – 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the

device disclosed by Fish to be used during a physical activity of hitting a ball with a bat because the correctness of the performance of hitting a ball with a bat is related to the movement of the head of the user (Col. 3, lines 64 – 67).

8. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,553,857 to Fish in view of U.S. Patent No. 5,978,972 to Stewart et al.

In reference to claim 78, Fish discloses a sensor positioned on a band wearable about a user's head (Figure 3), but fails to disclose at least three sensors being positioned around the band. Stewart et al. teach having at least at least three sensors being positioned at locations about 90°, 180° and 270° on a headgear for recording head motion data (Col. 52 – 65). It would have been obvious to modify the band as disclosed by Fish to include at least three sensors being positioned around the band as taught by Stewart et al. in order to receive more accurate head motion data.

9. Claim 79 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,553,857 to Fish in view of U.S. Patent No. 5,592,401 to Kramer.

In reference to claim 79, Fish fails to disclose the sensor being a gyroscopic sensor or an accelerometer sensor. However, Fish discloses the sensor being any of a many varieties commonly known to the trade for sensing motion and position (Col. 4, lines 7 – 9). Kramer teaches the use of both gyroscopic sensors and accelerometer sensors for sensing motion and position (Col. 6, lines 32 – 39). The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Because both Fish and Kramer teach means for sensing motion and position, it would have been obvious to one skilled in the art at the time of the invention to substitute a gyroscopic sensor or accelerometer sensor as taught by Kramer for the sensor disclosed by Fish for the predictable results of sensing motion and position of the moving body.

10. Claims 80 - 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,553,857 to Fish in view of U.S. Patent Application Publication 2002/0151994 to Sisco.

In reference to claims 80 - 82, Fish fails to disclose a user interface for inputting information relating to a club type or two different types of sports activities. Sisco discloses a user interface to enable the user to input information relating to club type [101] and two different types of sports activities [0110][0119]. It would have been obvious to one having ordinary skill in the art to modify the device disclosed by Fish to include a user interface to enable the user to input information relating to club type and two different types of sports activities as taught by Sisco in order to make information on one or more golfer's play available to a golfer playing a round of golf after the round has been completed [0002].

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN ML FOREMAN whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. F./  
Examiner, Art Unit 3736

/Max Hindenburg/  
Supervisory Patent Examiner, Art Unit 3736